

REMARKS

At the time of the Office Action dated August 8, 2005, claims 1-16 were pending and rejected in this application. Independent claims 1, 11, and 14 have been amended to clarify that the means for selecting a message filter policy is separate from the publisher and subscriber application programs, and this amendment finds adequate descriptive support throughout the originally-filed disclosure, for example, on pages 23-25. Claim 15 has been cancelled. Applicant submits that the present Amendment does not generate any new matter issue.

**CLAIMS 1-4 AND 10-16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON OWENS ET AL., U.S. PATENT NO. 6,633,630 (HEREINAFTER OWENS), IN VIEW OF
NARASIMHAN ET AL., U.S. PATENT NO. 6,073,165 (HEREINAFTER NARASIMHAN)**

On pages 3-8 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan to arrive at the claimed invention. This rejection is respectfully traversed.

Owens does not teach the claimed means for selecting a message filtering policy which is appropriate for a communication characteristic

In the first paragraph on page 3 of the Office Action, the Examiner asserted that "means for selecting a message filtering policy which is appropriate for the communication characteristic" is disclosed in Figs. 3, 5-6, and 8; and in column 8, lines 34-36, column 10, lines 24-56 of Owens. Applicant respectfully disagrees. Although Applicant admits that Owens discloses the selection of a

filtering policy (i.e., the receivers and senders of messages may select options for defining rules to send and receive notifications of incoming messages), Owens fails to teach or suggest the claimed "communication characteristic."

As recited in claim 1, the communication characteristic is "of an inter-broker communication link between the message broker system and one of said connected message brokering systems." The Examiner's assertion that Owens teaches the claimed "communication characteristic" ignores this further limitation as to what constitutes the claimed communication characteristic. In so doing, the Examiner has failed to consider the claimed invention, as a whole. Therefore, Applicant submits that Owens cannot be relied upon to teach any portion of the above-identified "means ... for selecting a message filtering policy" clause since Owens is completely silent as to the claimed "communication characteristic," which is an integral and inseparable part of this clause.

In the third paragraph on page 3 of the Office Action, the Examiner admitted that:

Owens did not expressively [sic] teach details regarding means, responsive to a communication characteristic of an inter-broker communication link between the message brokering system and one of said connected message brokering systems.

Applicant notes that this assertion is completely opposite to the Examiner's assertion in the first paragraph on page 3 of the Office Action, which is directed to the same limitation. In this regard, Applicant proceeds on the basis that the Examiner intended to assert that Owens did not teach the details regarding the claimed communication characteristic. Notwithstanding this ambiguity, Applicant maintains the argument that Owens also fails to teach the entirety of the claimed "means ... for selecting a message filtering policy" clause.

Narasimhan's *rerouting* based upon a communication characteristic is not comparable to the claimed selecting a message filtering policy appropriate for a communication characteristic

On page 3 of the Office Action, the Examiner cited column 7, lines 2-14 of Narasimhan to teach "selectively taking a configurable course of action depending on the link conditions or characteristics." At the outset, the teachings found in the paragraph spanning columns 6 and 7 of Narasimhan is simply related to "the provision for redundancy by the inclusion of an alternate source sever 177, mirrored database 119, and alternate destination server 125." If one of the servers of Narasimhan goes down, a message can be rerouted via a redundant resource or connection. Thus, Narasimhan merely teaches rerouting based upon a communication characteristic (e.g., a server has failed).

Moreover, the teachings of Narasimhan regarding the provision for redundancy by the inclusion of alternate servers (i.e., rerouting) is completely unrelated to Narasimhan's teachings regarding filtering. Message filtering in a content processor 303 is discussed in column 5, lines 4-35 of Narasimhan, and there is no apparent relationship between the function provided by the content processor 303, which is located in source server 103 (see Fig. 3), and the provision of redundant servers. Therefore, the teaching is Narasimhan of rerouting based upon a communication characteristic is completely unrelated to message filtering.

Owens does not teach *automatically* selecting filtering policies

With regard to the underlined portion in the paragraph spanning pages 3 and 4 of the Office Action, Applicant does not disagree that both Owens and Narasimhan teach message filtering. Applicant, however, submits that the Examiner has mischaracterized the teachings of Owens when the Examiner asserted that "Owens motivated to exploration of the art of automatically selecting filtering policies (column 8 lines 29-31)." For ease of reference column 8, lines 27-42 of Owens is reproduced below:

Referring to FIG. 3, the flow of data between two access service providers in accordance with a preferred embodiment of the present invention is shown. As shown in FIG. 3, inbound fax mail and voice mail messages are first processed by a telephone access service (e.g., Premiere.) Depending on the options selected by the sender and receiver, messages and/or notifications may be forwarded to the computer access service (e.g., CompuServe.) Inbound e-mail messages are first processed by a computer access service (e.g., CompuServe.) Depending on the options selected by the sender and receiver, messages and/or notifications may be forwarded to the telephone access service (e.g., Premiere.) Also, depending on the options selected by the receiver, rules may be applied to messages so they are converted automatically from one communication medium to another.

As evident from the above-cited passage, Owens does not teach automatically selecting filtering policies. Instead, options (i.e., the Examiner's asserted filters) are selected by the sender and receiver. Although rules may be applied to message to automatically convert the message from one communication medium to another, there is no teaching within Owens that the rule/option itself is automatically selected.

Proposed combination would not result in claimed invention

In paragraph spanning pages 3 and 4 of the Office Action, with regard to the proposed combination of Owens and Narasimhan, the Examiner asserted the following:

Therefore, Owens modified by Narasimhan (**the combination**) would have resulted improved by [sic] filtering automatic messages transmission based in rules or policies specified by sender/receiver (**Owens: column 10 lines 24-34**) and based on transmission link conditions, characteristics or the like

(Narasimhan: column 7 lines 2-14) and further minimizing downtime associated with repairs
(Narasimhan: column 7 lines 15-19). (emphasis in original)

Despite the tortured grammar of this sentence, Applicant notes that one having ordinary skill in the art, even if motivated to modify Owens in view of Narasimhan, would not have arrived at the claimed invention. Moreover, the Examiner's proposed combination ignores the claimed invention, as a whole.

As already noted, both Owens and Narasimhan teach message filtering. The Examiner's proposed modification (i.e., column 7, lines 2-14 of Narasimhan) and motivation (i.e., column 7, lines 15-19 of Narasimhan) is directed to providing redundant servers through which messages can be rerouted in case of sever failure (either unintentional or intentional - e.g., to upgrade or repair one of the servers). Therefore, one having ordinary skill in the art, upon modifying Owens in view of Narasimhan would add redundant communication servers/nodes to the system disclosed in Fig. 1 of Owens such that if one of the communication servers/nodes 26, 28, 30, 32 failed, a redundant sever/node would be able to forward a message from the message sender 34 to the message receiver 36. This combination of Owens and Narasimhan, however, fails to teach or suggest the claimed limitation recited in claim 1 of "means ... for selecting a message filtering policy which is appropriate for the communication characteristic" and the means being "responsive to a communication characteristic of an inter-broker communication link between the message brokering system and one of said connected message brokering system."

Applicant notes that Examiner's specifically asserted that the combination of Owens and Narasimhan would be improved by "filtering automatic message transmission ... based on

transmission link conditions." Not only does Narasimhan fail to teaching filtering messages based on transmission link conditions, the Examiner's asserted combination fails to teach the claimed invention, which recites "means ... for selecting a message filtering policy which is appropriate for the communication characteristic" (emphasis added). Neither Narasimhan, Owens, nor a combination of these references links (i) the selection of a message filter policy with (ii) a communication characteristic of an inter-broker communication link between message brokering systems. Therefore, even if the references were modified, as suggested by the Examiner, the claimed invention would not result.

Claims 1, 11, and 14

Independent claims 1, 11, and 14 have been amended to clarify that the means for selecting a message filter policy is separate from the publisher and subscriber application programs. However, the features in Owens that have been argued as corresponding to these claimed features (i.e., the message sender 34 and message receiver 36) are the same entities that select the "options for defining rules" (see column 3, lines 34-36) that the Examiner argues corresponds to the claimed selecting a message filtering policy. Thus, Owens fails to teach or suggest the limitations recited in amended claims 1 and 14. Furthermore, to modify Owens such that the selection of the message filtering policy is made by someone other than the message sender 34 and message receiver 36 would impermissibly changed the principle of operation of Owens. In this regard, the Examiner is referred to the paragraph entitled "THE PROPOSED

MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A
REFERENCE" in M.P.E.P. § 2143.03.¹

Claim 16

Independent claim 16 recites "responsive to a communication characteristic for a communication link between the message brokering system and another message brokering system, selecting a message filtering policy according to the determined communication characteristic." These features are comparable to the claimed means for selecting a message filtering policy, and Applicant incorporates herein the arguments previously-presented with regard to this limitation. Specifically, even if Owens were modified in view of Narasimhan, the claimed invention would not result.

Claim 2

On page 5 of the Office Action, the Examiner cited column 8, lines 39-42 of Owens as teaching that the communication characteristic used to select a message filtering policy is a communication protocol provided by the communication link. Applicant respectfully disagrees. As already noted many times throughout this response, the message filtering policy (i.e., "the rules [] applied to the message so they are converted automatically from one communication medium to another") is selected by the sender and/or receiver of Owens. This is different than selecting a message filtering policy that is appropriate for the communication characteristic. In Owens, the conversion from one communication medium to another is based upon the rules (i.e.,

¹ If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

the asserted filtering), whereas in the claimed invention, the message filtering policy is based upon the communication characteristic.

The remaining of the Examiner's discussion on page 5 of the Office Action also fails to address Owens' and Narasimhan's failure to teach using a communication protocol to select a message filtering policy. Furthermore, to the extent that the Examiner relies upon Narasimhan to teach any of the limitations recited in claim 2, the Examiner has failed to establish a motivation to modify Owens in view of Narasimhan. The motivation to modify Owens in view of Narasimhan asserted by the Examiner with regard to claim 1 only applies to claim 1 since the motivation is specific to the modification. Since the Examiner has argued an additional modification, the Examiner is required to factually establish another motivation.

Claim 3

On page 6 of the Office Action, the Examiner cited column 8, lines 39-42 of Owens as teaching the comparing and storing steps recited in claim 3. Applicants respectfully disagree. The Examiner is asserting that Owens discloses certain claimed features without precisely identifying those features in the applied prior art.

For the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 1-4, 10-14, and 16 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan is not viable and, hence, solicits withdrawal thereof.

**CLAIMS 5 AND 6 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OWENS IN VIEW OF NARASIMHAN, HURST ET AL., U.S. PATENT NO. 6,131,121 (HEREINAFTER
HURST), AND KHAN ET AL., U.S. PATENT PUBLICATION NO. 2002/0143951 (HEREINAFTER
KHAN)**

On pages 8 and 9 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Hurst, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 5 and 6 depend ultimately from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan. The additional references to Hurst and Khan do not cure the argued deficiencies of Owens and Narasimhan. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Hurst, and Khan is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 7 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OWENS IN VIEW OF NARASIMHAN, AND DELANEY ET AL., U.S. PATENT PUBLICATION NO.
2001/0027479 (HEREINAFTER DELANEY)**

On pages 10-11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan and Delaney to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 7 depends ultimately from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan. The additional reference to Delaney does not cure the argued deficiencies of Owens and Narasimhan. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Delaney is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 8 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OWENS IN VIEW OF NARASIMHAN, DELANEY AND KHAN**

On pages 11-13 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Delaney, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

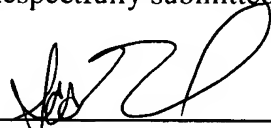
Claims 8 and 9 depend ultimately from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan. The additional references to Delaney and Khan do not cure the argued deficiencies of Owens and Narasimhan. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claims 8 and 9 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Delaney, and Khan is not viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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42196